



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|---------------------|------------------|
| 09/923,042 | 08/06/2001 | Marilyn Wood Blaschke | 194-26572-US | 8965 |

23770 7590 09/28/2004

PAULA D. MORRIS & ASSOCIATES, P.C.
d/b/a THE MORRIS LAW FIRM, P.C.
10260 WESTHEIMER, SUITE 360
HOUSTON, TX 77042-3110

EXAMINER

MANOHARAN, VIRGINIA

ART UNIT PAPER NUMBER

1764

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------|--|--|
| Office Action Summary | Application No. 09/923,042 | Applicant(s) BLASCHKE, MARILYN WOOD | |
| | Examiner Virginia Manoharan | Art Unit 1764 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-28, 30-32, 35-66 and 68-113 is/are pending in the application.
- 4a) Of the above claim(s) 47-66 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38-46 is/are allowed.
- 6) ☐ Claim(s) 16-28, 30-32, 35- 37, 68-113 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 79-102 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed "non-aqueous blend" e.g., in claim 79. is nowhere in the specification. In fact, at page 4, lines 18-23, the specification recites "...According to the present invention, the blend is distilled at temperatures that free the extractive distillation solvent from both lower and higher boiling contaminants, including, but not necessarily limited to water (by azeotropic distillation with solvent), 1,3-..." However, if support can be pointed-out at least. the specification is objected to as failing to provide proper antecedent basis for the claimed subject matter, as the above limitation is not positively recited in the specification.. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). [In amending claims, care must be exercised to avoid introduction of anything which could be construed to be new matter prohibited by 35 U.S.C. 132 and 37 CFR 1.121.]

Claims 16-28', 30-32, 35, 37, 68-78 & 109-113 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) The claims are rejected for the same reasons as set forth at section (a), page 2, of the previous Office action. [Since applicant did not address this rejection, it is assumed she/he is acquiescing therein].

Art Unit: 1764

(b) Claim 109, claim 112 and claims 110 and 113 do not substantially differ from one another as required by 37 FR 1.75 (b) as far as positive, manipulative method steps are concerned. The difference seen is in "product" e.g., the blend comprising solvent and at least one fouling agent in claim 12, as opposed to at least one fouling agent in claim 109. However, "product" is not the basis of patentability of a method or process claim.

(c) The "comprising" and "comprises" in the Markush grouping, e.g., only claim 79, last line, the "comprising rosin acid..." and claim 80 lines 34, " comprises a nitrogen..." provide for ambiguity and confusion. [Those reviewing a claim from either a patentability or infringement view point are capable of knowing exactly what the Markush group is in proper form. In the instant case, one simply does not know what is intended to be included within the Markush group as it is all-inclusive with the recitation of "comprising" and "comprises"]. Applicant should further check all the other claims with the same terms above in the Markush grouping.

(d) Claims 81 and 82 are at odd with the claims from which they depend directly or indirectly, i.e., claims 79 & 80 respectively. [A dependent claim can not change or orient limitations already recited in the claims from which they depend].

(e) The specific N,N-di substituted amide is not specifically claimed e.g., in claim 79 and claims dependent thereon nor in the specification.

Claims 79-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollis et al abstract (S. African ZA 680533) or Ferm (4,410,419) in view of Devicaris et al (5,243,063).

The above references are applied for the same reasons as set forth at page 4 of the previous Office action. Devicaris is applied to teach, abstract, that the process of inhibiting fouling in an organic process stream which is substantially non-aqueous is known in the art. To incorporate Devicaris to Hollis or Ferm process would have been obvious to one of ordinary skill in the art as the references are directed to solving similar fouling problems

Claims 16-28, 30-32, 35-37, 68-78 & 109-113 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claims 38-46 are allowed.

This application contains claim 47-66 drawn to a nonelected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant's arguments filed May 4, 2004 have been fully considered but they are not persuasive.

However, Devicaris, and not Hollis, was applied to teach that the argued "scale prevention compound to prevent fouling of equipment in non-aqueous system is not unobvious nor is it evidence of criticality in the art. Furthermore, applicant's argument such as the moiety: $\text{CH}_3 - (\text{CH}_2)_x - \text{---} (\text{CH}=\text{CH})_y - (\text{CH}_2)_z \text{---}$ from Ferm's structure corresponds to "R" in the claims. In the pending claims, "R³ is selected from the group consisting of a combination of tall oil fatty acids comprising acid, aryl..." is not considered well-taken. Ferm's dialkyl fatty acid amide is deemed to read on the

Art Unit: 1764

claimed structure since it falls within the claimed N-N disubstituted amide as broadly claimed e.g., in claim 79. Compare further with the agent claimed in claim 112.

The argument relative to the alternative reference to Stanley is moot in view of the above rejection.

Thus, in the absence of anything which may be "new" or unexpected result", a prima facie case of obviousness has been established by the art and has not been rebutted.

Unexpected results must be established by factual evidence. Mere arguments or conclusory statements in the specification, applicants, amendments, or the Brief do not suffice. In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972). In re wood, 582, F. 2d 638, 642, 199 USPQ 137,140 (CCPA 1978).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Syrinek discloses a dispersant/antifoulant including hydrocarbonaceous sulfonic acids which may optionally admixed with polar solvents such as tall oil fatty acids.

(b) McClain et al discloses inhibition of fouling in petrochemical processes.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Virginia Manoharan whose telephone number is 571-271-1450. The examiner can normally be reached on Tuesday-Friday from 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/923,042

Page 7

Art Unit: 1764

V. Manoharan/af
September 16, 2004


VIRGINIA MANOHARAN
PRIMARY EXAMINER
ART UNIT 1251764